

AMENDMENT

IN THE CLAIMS

Please amend the claims as indicated in Appendix A submitted herewith according to the July 30, 2003, revision to 37 C.F.R. § 1.121 concerning a manner for making claim amendments.

REMARKS

Claims 1-4 are pending in the captioned application.

Subsequent to the enclosed amendment, claims 1 and 2 are currently amended; claims 3 and 4 are as originally filed; and claims 5-9 are newly added.

Claim 1 has been amended to recite the specific catalyst activity point of at or around "44,800 g-polymer/g-catalyst". Claim 2 has been amended to change to recite the specific catalyst activity point of at or around "52,900 g-polymer/g-catalyst". Support for the amendment can be found in the claims themselves. New claims 5-9 recite specific catalyst activity points as well.

For example, claim 5 recites the activity point of at or around "49,500 g-polymer/g-catalyst" wherein support for the

amended range can be found in Example 3 of Table 3 found on page 41 of the specification.

Claim 6 recites the activity point of at or around "49,700 g-polymer/g-catalyst" wherein support for the activity point can be found in Example 2 of Table 3 found on page 41 of the specification.

Claim 7 recites the activity point of at or around "50,100 g-polymer/g-catalyst" wherein support for the activity point can be found in Example 1 of Table 3 found on page 41 of the specification.

Claim 8 recites the activity point of at or around "52,800 g-polymer/g-catalyst" wherein support for the activity point can be found in Example 5 of Table 3 found on page 41 of the specification.

Claim 9 recites the activity point of at or around "54,600 g-polymer/g-catalyst" wherein support for the activity point can be found in Example 7 of Table 5 found on page 45 of the specification.

No new matter within the meaning of § 132 has been added by any of the amendments.

Accordingly, Applicants respectfully request the Examiner to enter the amendments and to reconsider and allow all claims pending in this application.

1. Rejection of Claims 1-4
under 35 U.S.C. § 112, ¶ 1

The Office Action rejects claims 1-4 under 35 U.S.C. § 112, ¶ 1 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office Action states:

The newly added catalyst activity limitations, at the end of Claim 1 of "52,900 to 54,600 g-polymer/g-catalyst" and at the end of Claim 2 of "52,900 to 54,600 g-polymer/g-catalyst", are new matter. Applicants have indicated support for the newly added limitations can be found in Tables 3 and 5 in the Specification on pages 41 and 45 respectively. However, those working examples are only provide supports for the individual catalyst activity points, they do not full provide for the whole ranges of catalyst activities of the instant claims.

Applicants respectfully traverse the rejection over the

presently pending claims for the reasons provided in the previously filed Response of March 4, 2003, and because sufficient evidence or reasoning to rebut the presumption of support was not adequately provided by the Examiner. See e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971) (holding that a description as filed is presumed to be adequate, unless the examiner presents sufficient evidence or reasoning to rebut the presumption). Applicants maintain that one of ordinary skill in the art would clearly understand that the Applicants had possession of the invention for the range between the points given the distance between the points and the understanding that Applicants need not disclosed every single infinitesimal data point along a range in order to be entitled to the entire range.

Nevertheless, in the interest of advancing prosecution, Applicants have deleted the ranges from the claims without prejudice or disclaimer and now claim specific data points for each of the Examples provided. In particular, the recited range of "44,800 to 52,800 g-polymer/g-catalyst" of claim 1 and the recited range "52,900 to 54,600 g-polymer/g-catalyst" of claim 2 have been amended to specific catalytic activity points that are fully supported by the Examples of the specification while new

claims 5-9 recite additional specific data points which are supported by the Examples of the specification.

Turning to the rule, 35 U.S.C. § 112, 1st paragraph states that the "specification shall contain a written description of the invention . . .". To satisfy the requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1550, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).

In the present application, claim 1 has been amended to recite the specific point of "44,800 g-polymer/g-catalyst". The catalyst activity limitation of claim 1 now recites a catalytic activity of 44,800 g-polymer/g-catalyst and a ratio of powdery polymer having a particle size of less than 100 μm of 1.5% by weight or below when used to polymerize ethylene for 2 hours at a temperature of 80°C and a partial pressure of ethylene of 4.0 kg/cm²-G.

As can clearly be seen by Table 3 on page 41 of the specification, the claimed point of 44,800 g-polymer/g-catalyst is supported by Example 4, which recites a catalytic activity of 44,800 g-polymer/g-catalyst. The specification describes in

sufficient detail the specific point of 44,800 g-polymer/g-catalyst where one of ordinary skill in the art could reasonably conclude that Applicants had possession of the claimed invention.

Similarly, claim 2 now recites a catalytic activity of 52,900 g-polymer/g-catalyst and a ratio of powdery polymer having a particle size of less than 100 μm of 0.6% by weight or below when used to polymerize ethylene for 2 hours at a temperature of 80°C and a partial pressure of ethylene of 4.0 kg/cm²-G.

As can clearly be seen by Table 5 on page 45 of the specification, the specific catalytic activity point of 52,900 g-polymer/g-catalyst is supported by Example 6, which recites a catalytic activity of 52,900 g-polymer/g-catalyst. From the example, one of ordinary skill in the art could clearly conclude that Applicants had possession of the specific catalytic activity point of 52,900 g-polymer/g-catalyst.

Regarding the presently claimed particle size, Applicants note that the continuation of Table 5 on page 45 shows a particle size of less than 100 μm of 0.6% by weight or below for Examples 6 and 7 as presently claimed in claim 2. As stated in the previous Response filed on March 4, 2003, Applicants again

note that the specification at page 32, lines 16-25 describes the polymerization conditions.

Finally, Applicants note that the added claims 5-9 recite the additional data points of the specification as provided in the Remarks section supra.

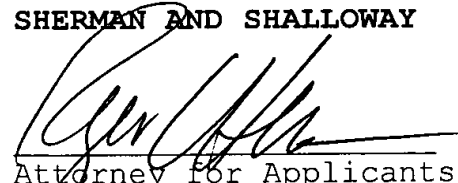
For all these reasons, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of claims 1-4 under 35 U.S.C. § 112, ¶ 1.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of the pending claims and allow the pending claims. Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,

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